

No. 15,104

IN THE

United States Court of Appeals
FOR THE NINTH CIRCUIT

ORIENTAL FOODS, INC.,

Appellants.

vs.

CHOW KING SALES, INC. and JEROME F. PAULECCI,

Appellees.

CHOW KING SALES, INC. and JEROME F. PAULECCI,

Appellees-Cross-Appellants,

vs.

ORIENTAL FOODS, INC.,

Appellate Cross-Appellee.

**OPENING BRIEF OF DEFENDANT-
APPELLANT ORIENTAL FOODS, INC.**

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Appellant-Cross-Appellee.

**OPENING BRIEF OF DEFENDANT-
APPELLANT ORIENTAL FOODS, INC.**

I.

STATEMENT OF JURISDICTION.

Jurisdiction of the District Court as to the patent issues is founded upon the patent statutes of the United States and Judicial Code of the United States [Complaint, Par. IV, R. 4]. Jurisdiction is admitted by defendant [Answer, Par. IV, R. 13].

The District Court's judgment was entered on January 11, 1956 [R. 91].

Within thirty days after defendant's timely motion to amend the Findings of Fact, which motion was denied on February 13, 1956 [R. 71], the defendant-appellant filed its notice of appeal on February 24, 1956 [R. 98]; and on March 6, 1956, filed an amended notice of appeal [R. 103].

Jurisdiction of the District Court over the patent issues, therefore, is founded on Title 28, Section 1338 of the United States Code. Jurisdiction of this Court of Appeals as to the appeal of the defendant-appellant Oriental Foods, Inc. is founded on Title 28, Section 1292(4) of the United States Code, and Rule 73(a) and (b), Federal Rules of Civil Procedure.

II.

STATEMENT OF THE CASE.

A. The Parties.

Plaintiff Chun King Sales, Inc. is the alleged exclusive licensee under Letters Patent No. 2,679,281 in suit. It is a large manufacturer of oriental-type food products at Duluth, Minnesota.

Plaintiff Jeno F. Paulucci is the owner of Letters Patent No. 2,679,281 in suit. He owns substantially 100% of the stock of plaintiff Chun King Sales, Inc.

Defendant Oriental Foods, Inc. is a California corporation having its place of business at Los Angeles, California. Defendant is also a manufacturer of oriental-type foods under the trademark "JAN-U-WINE".

B. The Issue.

The Complaint charges infringement by the defendant of United States Letters Patent No. 2,679,281 [PX-1, R. 541] owned by plaintiff Paulucci and allegedly licensed to plaintiff Chun King Sales, Inc. [R. 6].

The Paulucci patent in suit contains three claims. Claim 1 covers a "method" and claims 2 and 3 cover an "apparatus" for practicing the method. The Complaint, in effect, alleges infringement by the defendant of both the method and apparatus claims [Par. XIII, R. 7], and

prays for an injunction enjoining the defendant from making or using such apparatus and the method [R. 10].

By a counterclaim filed on April 14, 1955, the defendant put in issue the validity and infringement by it of *all* of the claims of the Paulucci patent in suit [R. 20-23].

At the trial of this action on November 22, 1955, *et seq.*, plaintiffs abandoned their charge of infringement of claims ^{2 and 3} 1 of the Paulucci patent in suit [R. 109; 506]. The defendant urged that the District Court should rule on claims 2 and 3 but the Court refused to do so [R. 517-519]. The defendant requested the District Court to make findings of fact as to both the lack of infringement and invalidity of claims 2 and 3 [R. 94-95], but the District Court refused to do so [R. 97].

The action was tried before the Honorable Leon R. Yankwich. The District Court's Opinion [R. 67], judgment [R. 89], and Conclusions of Law [R. 88] held method claim 1 of the patent in suit valid and infringed by the use of a machine owned and operated by the defendant Oriental Foods, Inc., but made no reference to apparatus claims 2 and 3.

The only general issues before this Court on the appeal of Oriental Foods, Inc. are as follows:

- (1) Has method claim 1 of the patent in suit been infringed by defendant?
- (2) Is method claim 1 of the patent in suit valid at law?
- (3) Are apparatus claims 2 and 3 of the patent in suit valid at law?
- (4) Have apparatus claims 2 or 3 of the patent in suit been infringed by defendant?

For brevity, plaintiff's exhibits are sometimes referred to herein as "PX" and defendant's exhibits "DX". All emphasis is ours unless otherwise noted.

C. The Paulucci Patent in Suit—Generally.

The Paulucci patent in suit relates to a method and means for taping two conventional cans of food together in end-to-end relationship by the use of a conventional pressure-sensitive tape, such as cellophane tape, sold under the trademarks "SCOTCH" and "TEXCEL". The object of this, as pointed out in the Paulucci patent, is simply a merchandising stunt to permit a merchant to sell two cans for about the price of one [R. 542]. As stated in the Paulucci patent such a selling idea is old, and lacking in novelty [Column 1, lines 3-30].

Claim 1 of the Paulucci patent covers the method of taping cans together so that they can be sold as a "2-in-1" sales combination. Claims 2 and 3 cover the very simple apparatus shown in the patent. This apparatus is nothing more than a small V-shaped trough, closed at one end, and fastened to a table top, spaced from a conventional tape dispenser.

Method claim 1 of the patent in suit has four separate method steps, as follows:

[1] "aligning said cans in end-to-end relationship with adjacent end beads of said cans abutting each other.

[2] "*stretching a portion of a slightly resilient sticky tape and applying said portion of said tape over portions of the abutting beads and adjacent side walls of said cans while said tape is in a stretched condition to secure said cans together,*

[3] "*pulling on the portion of said tape not secured to said can in a direction substantially tangential to*

the periphery of the cans to place same in a *stretched condition*,

[4] “and rotating said cans on their longitudinal axes while said tape is in said *stretched condition* to cause said tape to be applied and to adhere to the *remainder of the periphery* of said beads and adjacent side walls of said cans.”

It is defendant's contention that neither plaintiffs, defendant, nor anyone else has ever used the method covered by claim 1 of the Paulucci patent in suit, *i.e.*, that it is a mere “paper patent” which is not infringed by defendant.

The method of the Paulucci patent in suit [R. 541], as described in the specification, is as follows:

- (a) two cans are axially aligned end-to-end [Column 3, lines 27-29];
- (b) the tape 3 is grasped by the operator with the thumb and forefinger of one hand grasping the end of the tape and the thumb and forefinger of the other hand grasping the tape about $1\frac{1}{2}$ to 2 inches behind the other hand [Column 3, lines 35-42];
- (c) the portion of the tape between the two hands is then *stretched* by pulling the hands apart [Column 3, lines 47-50];
- (d) the stretched end of the tape is then applied over the beads of the two cans *while stretched* [Column 3, lines 51-58];
- (e) the tape is then cut off to a length sufficient to encircle the cans [Column 3, lines 63-67];
- (f) the free cut end is then pulled away from the cans to *stretch* the loose tape [Column 3, lines 67-72]; and

(g) while the tape is held in *stretched condition*, the cans are rotated in a direction tending to wind the tape around the cans while the tape is held under tension to stick *the remainder* of the tape to the cans to hold them together [Column 3, line 72, to Column 4, line 9]:

The very simple apparatus shown in the Paulucci patent is covered by claims 2 and 3 thereof, of which claim 2 as follows is illustrative:

“2. Means for securing cans together in end-to-end relationship comprising a base, a V-shaped trough secured to said base to receive said cans in said relationship and to permit the rotation of said cans together on their longitudinal axes, a holder carried on said base in spaced relation to said trough, means on said holder to receive and hold a roll of tape, and a cutter carried intermediate said trough and said means to guide and support said tape.”

This apparatus covered by claims 2 and 3 is merely a V-shaped trough or “angle iron” and a conventional tape dispenser.

D. Plaintiff's Early Commercial Use of a Similar Method and Apparatus.

Although the application for the Paulucci '281 patent was not filed until May 14, 1952, the plaintiffs as early as May, 1949, were commercially using a very similar method of taping cans together end-to-end.

Plaintiff Paulucci admitted that starting in about May, 1949, and continuing through until August, 1951, he and his company, plaintiff Chun King Sales, Inc., were using substantially the same apparatus as is shown in the Paulucci patent in suit (and claimed in claims 2 and 3)

to tape cans together end-to-end [R. 43-45, 60-63]. In particular, Paulucci admitted that such apparatus was substantially as shown in the photograph DX-A and B [R. 552-553, 193-195]. This fact is amply corroborated by the other witnesses Cronin [R. 204-206], Peterson [R. 284], and Hammond [R. 370-376, 387-389].

As admitted by Paulucci, and as amply corroborated by plaintiffs' employees, plaintiffs commercially sold thousands of cases of cans of food so taped together in 1949, 1950, and 1951 [R. 53, 64, 190-191, 401, 406-407, 420, 428].

During such taping operations, plaintiffs' plant was open and no secrecy was attached to plaintiffs' operations [R. 56].

In such early taping operations plaintiffs used the same kind of tape later allegedly used in practicing the method of the patent in suit [R. 36, 428, 436], it being a standard product on the open market. In such early taping operations, plaintiffs used a V-shaped trough to hold and align the cans and a conventional heavy duty tape dispenser [R. 44-45, 63, 193-195, 205-206, 284, 371-376].

In the 1949 commercial taping method of plaintiffs, a girl aligned two cans in a V-shaped trough, withdrew a length of tape from a tape dispenser, tabbed the loose end of the tape down over the juncture of the two cans, and then rotated the cans to wind the tape onto the cans and secure them in end-to-end relationship [R. 39-40, 45, 119, 122, 195-198, 205-207, 373-376, 428-429].

As admitted by the plaintiff Paulucci, the only difference between plaintiffs' taping operations in 1949, 1950, and early 1951 and its later taping operations (allegedly in accordance with the method of claim 1 of the patent) was merely that in its later operations more tension was

put on the tape while being wound on the cans than theretofore [R. 198-199]. Even in plaintiffs' early taping operations sufficient tension was put on the tape to make it go on the cans smoothly [R. 206, 295-297].

It is defendant's contention that with the only difference between the patented method of claim 1 and plaintiffs' 1949, 1950, and early 1951 taping operations being the amount of tension applied to the tape during winding on the cans, claim 1 is invalid for lack of invention, since applying more tension to get a smoother application of the tape is merely a matter of ordinary mechanical skill. This would occur to anyone desiring to tape two cans together. It is also defendant's contention, of course, that such early public commercial use of the apparatus shown in the patent in suit invalidates claims 2 and 3 thereof.

E. Defendant's Early Commercial Use of a Similar Method.

Defendant Oriental Foods, Inc., likewise started taping cans together end-to-end manually in June, 1949, and continued this hand operation until early 1950 when it temporarily discontinued its hand-taping operations [R. 270-272, 468-469, 472, 473-474], to recommence its hand-taping operations in 1954, which continues to this day without substantial deviation [R. 468-469].

During 1949, defendant had at least six girls manually taping cans together end-to-end continuously [R. 475]. During 1949 defendant sold thousands of cases of cans so taped together [R. 470, 475-482]. Such taped product of defendant was advertised by it in 1949 [R. 271-272]. Some of its many early sales thereof are shown by Exhibits AE-1 and AE-2 [R. 475-482].

In defendant's 1949 hand-taping operation, defendant did not use any jigs or fixtures such as shown in the Paulucci patent. A girl would stack two cans, one on top of the other; would hold the cans together with the left hand; take a piece of sticky cellophane tape precut to the proper length in the right hand; tab one end of the loose tape onto the cans over the junction beads thereof; and then rotate the cans with the left hand while holding the tape tight with the right hand, to wind the tape on the cans [R. 469, 471, 473-475].

It is defendant's contention that if plaintiffs' present manual taping method were held to be that defined by claim 1 of the Paulucci patent, then defendant's 1949 commercial hand-taping operation would make claim 1 invalid because of such commercial use of the alleged patented method more than one year prior to the application on May 14, 1952, and long prior to any alleged invention by Paulucci of the subject matter of claim 1.

F. The File-Wrapper History of the Paulucci Patent in Suit.

In his original application for the patent in suit, plaintiff Paulucci submitted method claim 1 of the patent as issued under the same number and in identical terms [R. 565]. Claim 1 was rejected by the Patent Office on certain prior art [R. 569]. In arguing against this rejection of claim 1, Paulucci through his attorney stated:

“By providing the V-shaped trough it is possible to tension the tape *in its first application* to the top beaded surfaces of the can[s] under tension *and then* to rotate the cans so that a very rigid winding under tension may be accomplished.” [R. 572.]

In the same argument, Paulucci's attorney also said:

"The novelty of the method is in the perfect alignment* in end-to-end relationship of the cans and the application of a resilient tacky tape under *strong* tension to positively insure the engagement of the tacky surface of the tape to the beads of the cans as well as the cans proper." [R. 571.]

The Patent Office then indicated claim 1 as allowable [R. 576].

Paulucci thereafter attempted to add a new method claim 4 to his application [R. 578], stating:

"Claim 4 is quite similar to claim 1 with the exception that instead of calling for the *stretching* of a portion of the resilient sticky tape to the can while in stretched condition, the tape is secured at one end to the aligned cans to anchor one end of the tape thereto. The remaining portion of the tape is then held and the cans rotated on their long longitudinal axes with the tape being pulled in a stretched condition thus causing the tape to be secured to the aligned cans in such a condition. In other words, *claim 1 might be interpreted to be limited to those conditions in which the tape is first stretched and then applied to the cans and would not cover the situation where one end of the tape is anchored to the can and then wrapped around the cans in a stretched condition.* It is submitted that substantially the same end result would accrue with respect to claim 1 and newly presented claim 4 and in substantially the same way. However, to avoid possible future attempts to escape infringement, an unwar-

*This is a false statement for there was no novelty in end-to-end alignment because the plaintiffs had been doing this since 1949 with the use of a V-shaped trough. [See DX A, B, C and D, Record 552-555 and annotated discussion at page 6, *supra*.]

ranted interpretation of claim 1 could be alleged in the manner as above suggested. Claim 4 would prevent such infringement."

The Patent Office refused to let Paulucci add said new method claim 4 to his application, stating in effect that it was "broader" than claim 1, and was unpatentable over the prior art [R. 581].

Paulucci, through his attorney, then argued [R. 582] in favor of method claim 4, stating:

"In Claim 1 some argument might be had that if you didn't stretch the tape before you secure the end to the can you would not be practicing the method defined therein. In other words, if you secured one end of the tape to the can and then stretched it would be outside the scope of Claim 1."

The Patent Office then [R. 583] again refused to permit Paulucci to add proposed new claim 4, stating:

"The Examiner still considers claim 4 broader than the claims of record in this application since this claim would, by applicant's own admission (second paragraph in amendment filed February 12, 1954, and second paragraph in letter filed March 29, 1954), make an act an infringement which act would not constitute an infringement of the claims of record herein."

Paulucci then acquiesced in the refusal of the Patent Office to allow him new method claim 4, and accepted his patent without it [R. 584].

It is defendant's contention that by such proceedings in the Patent Office, claim 1 of the Paulucci patent is limited to a method in which a portion of the tape (e.g., 1½ or 2 inches) is stretched before any application to the cans and before rotation of the cans, such portion

being held in stretched condition while being applied to the cans, and that since neither plaintiffs nor defendant stretches any portion of the tape before application to the cans, the Paulucci patent in suit is a mere “paper patent” and defendant does not infringe it.

G. Defendant’s Machine—Generally.

The District Court held that defendant’s operation of its *machine* demonstrated at the trial infringes the Paulucci patent in suit [R. 71].

Defendant’s machine in issue was purchased by it on May 3, 1954, for the sum of \$1550.00 from the manufacturer, Dellenbarger Machine Company, New York City [R. 100]. This was prior to the issuance of the Paulucci patent in suit, and long prior to any knowledge by defendant of the patent in suit [R. 100]. Such machine is sometimes hereinafter referred to as “defendant’s Dellenbarger machine.”

Defendant’s Dellenbarger machine is illustrated in the photographs PX-21A to 21-G [R. 545-551]. The machine itself was demonstrated at the trial [R. 154 *et seq*] and at that time marked for identification as plaintiffs’ Exhibit 21, but was not offered into evidence because it is used in defendant’s ordinary commercial operations [R. 100].

Defendant’s Dellenbarger machine is of the semi-automatic type. An operator turns on the motor, puts two cans of food aligned end-to-end in the machine, then actuates a starting lever. The machine then automatically tabs a loose end of tape, under no tension whatsoever, to the aligned cans; rotates the cans to encircle the joint with the tape; and automatically ejects the taped cans when the taping is completed.

The defendant's Dellenbarger machine does not include any V-shaped trough, as specified by apparatus claims 2 and 3. Defendant's machine is shown in the photographs Exhibits 21-A to 21-G, inclusive [R. 545-551] and in the engineering drawing which is physical Exhibit 31.

H. The Background as to Defendant's Dellenbarger Machine.

The defendant's Dellenbarger machine was made by the Dellenbarger Machine Company under license from Minnesota Mining & Manufacturing Company under its patent to Johnson No. 2,652,166, DX-S [R. 659], the latter company being referred to hereinafter as "Minnesota Company."

In the Fall of 1950, the witness Peterson designed and built a prototype can taping machine while employed by Minnesota Company [R. 278-279; 282-283; 334-335]. This prototype machine was delivered to plaintiffs' plant in Duluth, Minnesota, in December 1950, or January, 1951 [R. 227]. The witness Peterson made two trips to plaintiffs' plant to adjust this prototype machine, one on January 31, 1951, and one in April, 1951 [R. 279-280, 285-287], which trips are fully documented in the record by DX-U and V [R. 668-674]. Judge Yankwich in his Opinion [R. 70] recognized that such use, which he characterized as an experiment, was "anticipatory of the invention," and Finding 21 [R. 86] expressly finds that such work by Minnesota Company was "prior to the invention of the patent in suit."

Such prototype machine built by Peterson incorporated a tape-applying mechanism like that shown in the earlier Minnesota Company drawing DX-T [R. 667; 282-283; 287], and as shown and described in the prior art patent

to Johnson No. 2,652,166, DX-S [R. 659; 311]. As will be noted, the original drawing DX-T is substantially identical with Figs. 4, 5, and 6 of the Johnson patent DX-S.

The Peterson prototype was also similar to defendant's accused Dellenbarger machine insofar as the tape-applying operation was concerned [R. 287-294].

A. E. Johnson (not the witness in this action) designed the type-applying mechanism shown in the drawing DX-T and Peterson used this drawing in building his prototype machine [R. 282; 287]. The drawing DX-T is dated 5/19/50, and the inventor A. E. Johnson filed his application for patent No. 2,652,166 (DX-S) thereon on May 29, 1950, which patent was assigned and issued to his employer Minnesota Company. The Johnson patent DX-S was issued on September 15, 1953, and is licensed to the Dellenbarger Machine Company. It shows substantially the same taping mechanism as incorporated in defendant's accused Dellenbarger machine [R. 305-310; 333-334].

Plaintiffs claim no date of conception of the alleged invention of the Paulucci patent in suit earlier than June, 1951 [R. 120], and since Paulucci had the Peterson prototype in plaintiffs' plant as early as January, 1951, and since defendant's accused Dellenbarger machine has substantially the same tape-applying mechanism as the prototype and operates in substantially the same way to tape cans together, if defendant's accused Dellenbarger machine is held to embody the alleged invention of the Paulucci patent in suit (which we submit it does not), the prototype machine likewise must be held to embody it; and the Paulucci patent must be held invalid; because he was not the inventor of the method of claim 1 having derived it from the Peterson prototype machine.

I. The Operation of Defendant's Dellenbarger Machine.

Plaintiff presented *no* testimony or written evidence bearing on the question of whether the operation of defendant's Dellenbarger machine embodies the *four* method steps defined by claim 1 of the Paulucci patent. The machine was demonstrated in Court at the trial; and plaintiffs' counsel stated that the machine was out of adjustment, and if so operated would not infringe [R. 509]. The machine operates at the rate of about 60 revolutions per minute [R. 329], i.e., it takes only *one second* for the machine to tape a pair of cans. We suggest that neither Judge Yankwich nor anyone else could determine whether the operation of the machine embodies the *four* separate method steps of claim 1 in suit merely by watching its operation. This personal observation was all that Judge Yankwich could point to in support of his holding of infringement [R. 71].

The only *evidence* in this action clearly demonstrates the non-infringing operation of the defendant's accused Dellenbarger machine. The witness O. M. Johnson, a mechanical engineer [R. 315], having had substantial experience with machines of this type in general and with defendant's accused machine in particular [R. 316-317], clearly explained the operation of defendant's machine, utilizing the diagrams Defendant's Exhibits X, X-1, X-2, X-3, X-4 [R. 675-679] to illustrate his explanation [R. 327-333]. The engineering witness Peterson likewise explained it [R. 305-310]. The following explanation of the operation of defendant's accused machine is related to the diagrams Exhibits X, X-1, X-2, X-3, and X-4, which are reproduced in substance for the convenience of the Court at pages 51-55, *infra*.

Exhibit X, see page 51, shows the pressure-sensitive tape in a heavy black line. The roll of tape is so labeled. It rotates freely in the dispenser. The large circle, labeled *Y*, represents the cans, aligned for application of the tape. The two smaller circles are rollers which rotate the cans.

The arm marked *O* is known as the buffing arm. At its free end is a soft buffing roller *P*, the purpose of which is to conform the applied tape to the surface to which it has been applied. The tape applying arm *M* is pivoted at a common point to the side of the machine with the buffing arm [R. 323].

The tape applying roller, the buffing roller, and the clutch roller* (all so labeled) are all free rolling; none of them is driven [R. 321, 322, 323]. The function of the buffing roller "is to firmly wipe the tape in contact with two cans" [R. 330].

In Exhibit X, see page 51, the tape-applying arm *M* and the buffing arm *O* are in the rest position before the taping cycle begins [R. 327]. In this position, the free end of the tape, hanging in air, is held between the applying roller *L* and the one-way roller *C*, the outer end being free [R. 328]. With the parts in this position, the operator then turns on the electric switch which starts the motor of the machine running, and places two cans *Y* end-to-end on the rollers *I*. Two cans are shown in defendant's machine in PX-21B [R. 546]. The operator

*The so-called clutch roller more properly should be called one-way roller. It is mounted with a ratchet to prevent reverse rotation so that the tape may not unthread. Since this roller is in contact with the adhesive surface of the tape, it is serrated [see DX 21-C, R. 547] to reduce the area of contact of the adhesive to the roller [R. 352] so that it will be easier to strip off as the roller rotates.

then releases a clutch trip lever (not shown), and thereupon the tape-applying arm *M* moves down towards the cans and the tape-applying roller tabs the free end of the tape into contact with the cans [R. 328].

The tape is neither stretched nor under any tension when so applied. Compare step 2 of claim 1.

The parts will then be in the position shown in Exhibit X-1 [R. 328], see page 52.

Up to this point no tension has been applied to the tape now in contact with the cans [R. 330]. Furthermore, this movement just described forms a slack "free loop" in the tape [R. 328-329]. Such "free loop" can be seen in the photograph PX-21D [R. 548], as well as in the reproduced exhibit.

The free loop is provided by contact, later in the cycle, of the tape with the pre-stripping roller, which freely rotates. The pre-stripping roller pulls the tape from the roll [R. 332]. The free loop is necessary to "insure a positive application of the tape to the cans initially", and so that "for the first increment of rotation the tape is not under any tension" [R. 332]. The tape "can be easily wiped to the can" to make "a more positive application" [R. 332].

The cans are then rotated counter-clockwise, the position after a small increment of such rotation being shown in Exhibit X-2 [R. 329], see page 53.

In the above position, the slack "free loop" has been reduced but has not been used up completely [R. 329], the tape applied to the cans having been "wiped" thereon by the buffing and applying rollers [R. 330]. Up to this point, no tension has been applied to the portion of the tape shown in contact with the cans [R. 330].

Continued rotation of the cans through a further segment of their cycle brings them to the position shown in Exhibit X-3, see page 54.

In this position, the "free loop" of tape has been taken up, and continued rotation of the cans strips tape from the supply roll [R. 330]. Up to this point, however, at which the cans have been more than 50% wrapped with tape, there has been no tension on the tape [R. 330].

Further rotation of the cans brings them to the position shown in Exhibit X-4, see page 55.

In this position, the tape has been wrapped completely around the cans with a small loose end for overlap and the tape-applying arm has moved up and away from the cans, drawing the tape across the knife to cut it as shown [R. 331].

The cans continue to rotate for a few degrees, which permits the buffing roller to wipe the last loose tab of tap onto the cans, and the arms move up together and back to the initial position shown in Exhibit X, *infra* [R. 331]. The taped cans are then automatically ejected from the machine, and it is ready for another cycle of operation.

The cellophane tape used in defendant's machine requires a pull of $7\frac{1}{2}$ pounds to stretch it. In the operation of defendant's machine the tape is not put under sufficient tension to stretch it [R. 345]. Furthermore, while the free loop is being utilized, that is, for one-half the encircling of the cans, there is no tension at all on the tape [R. 330].

It is defendant's contention that in the operation of its Dellenbarger machine, the tape is never under tension sufficient to stretch it and there is no initial pre-stretch-

ing of any portion of the tape before it is applied to the cans, all as required by method claim 1 of the Paulucci patent in suit, and that therefore defendant's operation does not infringe the patent in suit.

J. The Prior Art.

The Johnson patent, DX-S [R. 659, application filed two years before Paulucci], covers the prototype upon which defendant's accused machine was patterned, and under which it was built [See: page 13, *supra*]. The taping mechanism of the Johnson patent is identical in function with that of defendant's accused machine [R. 305-311, 333-334]. The Johnson patent shows in Figs. 4, 5, 6, a taping mechanism substantially identical with that of defendant's accused machine [compare Exhibits X to X-4, *infra*], including a tape-applying arm 70 carrying a tape-applying roller 72 and a clutch roller 73 between which the tape passes, and a separate buffing arm 77 carrying a buffing roller 79 and a knife 80. Such form of the Johnson device is clearly described in the Johnson patent [Column 4, line 30 to Column 5, line 23]. A pre-stripping roller 122, similar to the pre-stripping roller in defendant's machine, is shown and fully described in the Johnson patent [Column 6, lines 21-66]. It is defendant's contention that if the operation of defendant's Dellenbarger machine infringes method claim 1 of the Paulucci patent in suit, the Johnson patent, which shows a similar machine, anticipates claim 1 and renders it invalid.

The Nifong patent, DX-K [R. 608] shows and describes a machine and method for winding tape on cans. The tape employed is a flexible cellophane tape having an adhesive thereon [p. 1, Column 1, lines 35-41]. While Nifong shows (Fig. 11) and describes its machine taping flat tobacco cans, it makes it clear that the machine may

be used to tape round cans [p. 1, Column 2, lines 23-27; p. 7, Column 2, lines 18-21]. The tobacco can of the Nifong patent has a bead or rib 146 around its top edge, against which the can top seats, as clearly illustrated in Figs. 1, 7, 11, and 16 [R. 608]. In the Nifong machine, "The leading end of the tape having the adhesive applied thereto, the adhesive not as yet having dried or set, is now brought into contact with the then stationary can, at the line of engagement between the body and the top or cover of the can. The can thus supported on end with the leading end of the tape in engagement therewith, is now turned for substantially a complete revolution while contacting with the taut tape [p. 1, Column 1, lines 45-54]." The Nifong patent, throughout, teaches the desirability of *holding the tape under tension* as the tape is wound on the cans, and this feature is claimed in the Nifong patent [See: Claim 51]. Such tension on the tape is sufficient to cause it to pass around the irregular contour of the bead 146 to smoothly engage the side walls of the can and top, this being clearly shown in Figs. 1, 3, 7, and 16 of the Nifong patent, exactly the same as that shown in Fig. 2 of the Paulucci patent in suit.

The Ruttan patent, DX-G [R. 595] shows it to be old in the art to secure two cans together end-to-end by applying a flexible adhesive tape or "paster" over the adjacent beads of the cans, and clearly shows the tape conforming to the curvature of the beads and extending down onto the side walls of the cans.

The Roehrl patent, DX-O [R. 644] likewise shows it to be old to join two containers together end-to-end by wrapping a sticky tape around the juncture, teaching that "SCOTCH" pressure-sensitive tape can be used for this purpose [Column 3, lines 42-48].

The Ewart patent DX-R [R. 655] shows the use of a V-shaped trough, formed by faces 23 and 27, to hold a number of cylindrical coins together in alignment end-to-end while they are wrapped, similar to the V-shaped trough 6 of the Paulucci patent in suit.

None of the foregoing patents to Johnson, Nifong, Rutan, Roehrl, or Ewart was considered by the Patent Office in connection with the application for the Paulucci patent in suit.

The other prior art patent in the record were all file-wrapper references considered by the Patent Office in connection with the application for the Paulucci patent in suit. They are included in the record to show what was before the Patent Office.

III.

SPECIFICATION OF ERRORS RELIED UPON.

1. The District Court erred in failing to find or recognize that: claim 1 of the Paulucci patent in suit is limited by its terms to a specific method, involving four steps, in a stated sequence; the steps include “stretching a portion (*e.g.*, $1\frac{1}{2}$ or 2 inches) of a resilient sticky tape and applying said portion of said tape over portions of the abutting beads and adjacent side walls of said cans while said tape is in stretched condition to secure said cans together”; the accused machine applies a free, loose and dangling end of the tape, neither stretched nor under any tension or tautness, in the initial application of the tape to the cans.

2. The District Court erred in failing to find or recognize that: the steps of the method of claim 1 also include “pulling” on the tape to apply it in a “stretched condition” to the “remainder of the priphery” of the cans; the accused

machine does not use these steps because, for about one-half the circumference, the tape is applied from a “free loop”.

3. The District Court erred in failing to find or recognize that: the applicant Paulucci sought by amendment to secure from the Patent Office a claim which did not require initial application of a portion of the tape in a “stretched condition”, as in the allowed claim (Claim 1 of the patent); such proposed claim was rejected; Paulucci acquiesced in the rejection; the plaintiffs, therefore, are estopped from applying Claim 1 to a method which does not utilize this step.

4. The District Court erred in failing to find or recognize that: more than one year prior to the date of filing of the application for patent No. 2,679,281 the plaintiff Chun King Sales, Inc. utilized in its commercial operations a method and apparatus which completely anticipates the method claimed in said claim 1, if the above quoted step is ignored, and the apparatus claimed in claims 2 and 3, and sold in the open market cans fastened together in end-to-end relationship by the utilization of said method and apparatus; the use by a patentee of a method and apparatus in packaging goods for commercial sale more than one year prior to the filing date of a patent application stands as a bar thereagainst, as a matter of law.

5. The District Court erred in failing to find or recognize that: any interpretation of said claim 1 which would support a holding of infringement by defendant's use of its method would make the claim invalid by reason of a prior

use bar; it would make said claim directly readable upon the commercial practice of plaintiff Chun King Sales, Inc. and others more than a year before the Paulucci application was filed.

6. The District Court erred in failing to find or recognize that: the patentee Paulucci did not make oath to bring the first inventor of any method of taping together two cans in end-to-end relationship which did not include the limitations of claim 1, including stretching an end portion of the tape (about $1\frac{1}{2}$ or 2 inches) and applying it in a stretched condition.

7. The District Court erred in failing to find or recognize that: any interpretation of claim 1 in suit which eliminates the limitations required by its terms and by the file history renders the claim invalid by reason of anticipation by prior patented art and prior public use.

8. The District Court erred in failing to find or recognize that: claims 1, 2, and 3 of the patent in suit are each invalid over prior patents and prior public use; the Patent Office was not advised of prior public uses, and failed to cite the most pertinent art.

9. The District Court erred in dismissing the counterclaim asking for a declaratory judgment that claims 2 and 3 of the patent in suit are invalid and not infringed by defendant, and in failing to so find.

10. Finding 7 [R. 83] is erroneous in finding that the alleged invention of the Paulucci patent in suit resides in causing the tape to pass around an irregular contour to engage the side walls of two abutting cans, or the beads

thereof in a stretched condition, whereby the tape is extended transversely of its length at an intermediate section, because unsupported by and contrary to the evidence.

11. Findings 8 and 9 [R. 84] are erroneous in finding that any problem existed in the art or that the Paulucci patent in suit teaches a solution to any such problem, because unsupported by and contrary to the evidence, and, in particular, because the method of claim 1 has never been used by plaintiff, defendant, or anyone else.

12. Finding 10 [R. 84] is erroneous in finding that the method of claim 1 of the Paulucci patent has had wide or any commercial success, because there is no evidence to support such a finding and all of the evidence is to the effect that neither plaintiff nor anyone else has ever commercially used such method.

13. Finding 11 [R. 84] is erroneous in finding that the method of claim 1 of the Paulucci patent in suit required the exercise of any inventive faculty, because there is no evidence to support such a finding and it is contrary to the evidence.

14. Finding 12 [R. 84] is erroneous in finding that the method of claim 1 of the Paulucci patent produces any result in excess of the accumulation of the separate steps of the claim, because there is no evidence to support such a finding, and errs in finding that the tape is extended transversely of its length at an intermediate section, because there is no evidence to support such a finding, the patent

in suit does not mention such a result, and it would be contrary to reason.

15. Finding 13 [R. 85] is erroneous in finding that claim 1 defines any invention, that plaintiff Paulucci was the first inventor, and that it overcame any problem in the art, because unsupported by and contrary to the evidence.

16. Findings 14 and 15 [R. 85] are erroneous in finding that the method used by defendant utilizes the steps and has the same mode of operation as the method of claim 1 or uses any invention of the patent in suit, because unsupported by and contrary to the evidence.

17. Finding 16 [R. 85] is erroneous in finding that defendant has failed to establish any instance of prior knowledge or invention of the invention of claim 1 in suit or any solution to any problem first solved by plaintiff Paulucci, because unsupported by and contrary to the evidence; in particular, defendant's method was known and used prior to any alleged invention thereof by Paulucci and if his claim 1 covers it, his patent is invalid.

18. Finding 17 [R. 85] is erroneous in finding that all prior attempts at a solution to the problem by both plaintiffs and defendant proved a failure and were abandoned, because unsupported by and contrary to the evidence; in particular, both plaintiffs and defendant successfully taped cans together end-to-end on a wide commercial scale long prior to any alleged invention by Paulucci.

19. Findings 18 and 19 [R. 86] are erroneous in finding that the prior art does not anticipate claim 1 in suit and

does not teach a solution to the alleged problem allegedly first solved by Paulucci, because unsupported by and contrary to the evidence.

20. Finding 20 [R. 86] is erroneous in finding that the prior methods of said Minnesota Company were unsuccessful and unworkable, because unsupported by and contrary to the evidence, and, in particular, because such prior methods are the same as that of defendant's method here held to infringe; and is erroneous in finding that such prior methods did not anticipate claim 1 in suit, because unsupported by and contrary to the evidence, and, in particular, because such prior methods are the same as those of the defendant held to infringe.

21. Findings 21 and 22 [R. 86] are erroneous in finding that the prior work and methods used by said Minnesota Company did not utilize the alleged invention of claim 1 in suit, and in finding that such work and methods was an unsuccessful experiment and not an anticipation, because unsupported by and contrary to the evidence.

22. Finding 23 [R. 87] is erroneous in finding that the method of claim 1 in suit is an invention over the prior methods utilized by said Minnesota Company, because unsupported by and contrary to the evidence.

23. Finding 24 [R. 87] is erroneous in finding that there was not established any prior public knowledge or use of the method of claim 1 in suit, because unsupported by and contrary to the evidence.

IV.

SUMMARY OF THE ARGUMENT.

Point 1—Claim 1 of the patent in suit is not infringed by defendant's use of its Dellenbarger machine, because Claim 1 includes the step of stretching an end portion of the tape (about 2 inches) and applying it while stretched, which step is not employed by defendant; and Claim 1 also includes other steps which likewise are not employed by defendant.

Point 2—Claim 1 of the Paulucci patent in suit is invalid on its face for lack of invention, consisting only of old and well-known steps and involving only simple mechanical skill.

Point 3—Claim 1 of the patent in suit is invalid for lack of invention over the prior public use by plaintiffs of a similar method.

Point 4—Claim 1 of the patent in suit is invalid for lack of invention over the prior public use by defendant of a similar method.

Point 5—Claim 1 of the patent in suit is invalid for lack of invention over the prior art patent to Johnson, DX-S.

Point 6—Claim 1 of the patent in suit is invalid for lack of invention over the prior art patent to Nifong, DX-K.

Point 7—Claims 2 and 3 in suit are invalid for anticipation, prior public use, and lack of invention over the prior art. Claims 2 and 3 in suit are not infringed by defendant.

V.

ARGUMENT.

Preface.

The findings adopted by the trial Court are largely in the nature of conclusions, involving mixed questions of fact and law. There is no real conflict of testimony on any straight fact question necessary to the decision in this case.

In respect to the scope of Claim 1, the disclosures in the prior art patents, and the presence or absence of invention over prior art patents and prior commercial or public uses, this Court is fully as able to reach a conclusion as the District Court.

See:

Sales Affiliates v. National Mineral Co., 172 F. 2d 608, 613 (C. C. A. 7th, 1949);

Himmel v. Serrick, 122 F. 2d 740, 742 (C. C. A. 7th, 1941).

POINT 1.

Claim 1 Is Not Infringed by Defendant's Use of Its Dellenbarger Machine.

The test of infringement of a method claim is whether the alleged infringing method includes the steps of the claim, which operate in substantially the same way to produce substantially the same result as those of the patent in suit.

See:

Craftint Mfg. Co. v. Baker, 94 F. 2d 369 (C. C. A. 9th 1938).

Claim 1 of the Paulucci patent in suit includes *four* separate steps in the method claimed. The omission of any one of these steps avoids infringement. It is defen-

dant's contention that the operation of its Dellenbarger machine does not include steps 2, 3, or 4 of claim 1, and thus avoids infringement.

Step No. 1 of Claim 1 in Suit is as Follows:

“aligning said cans in end-to-end relationship with adjacent end beads of said cans abutting each other,”

Obviously, in the operation of defendant's machine, the cans are initially aligned end-to-end, as specified in “Step 1” of claim 1 in suit.

Step No. 2 of Claim 1 in Suit is as Follows:

“stretching a portion of a slightly resilient sticky tape and applying said portion of said tape over portions of the abutting beads and adjacent side walls of said cans while said tape is in a stretched condition to secure said cans together,”

This step is plainly described in the specification of the Paulucci patent as follows: “The portion 14* of the tape between the operator's two hands is then stretched or pulled between the fingers of the two hands, by pulling the hands away from each other, and is maintained in stretched condition, under tension, as it is applied over the abutting beads 11 and 12 [Column 3, lines 47-53].”

The point is that in step 2 of the Paulucci method the tape is stretched before applied to the cans and is applied in such stretched condition. This is exactly the interpretation put upon this step of claim 1 by Paulucci's attorney and the Patent Office during the prosecution of the application for the Paulucci patent.

*About “one and one-half to two inches beyond the end 10 of the tape” [Column 3, lines 41-42].

Under Remarks in his first amendment [R. 571] the applicant stated:

“The novelty of the method is . . . the application of resilient tacky tape under *strong* tension . . .”

Five months after the Johnson patent issued (September 15, 1953) showing the tape-applying method of the accused machine, namely, tabbing a dangling end of tape to abutting ends of cans, Paulucci sought to add claim 4 by amendment after allowance, on February 12, 1954 [R. 578]. This claim 4, as to step 2 of the method, was in these words:

“attaching one end of a strip of resilient sticky tape over portions of the abutting beads and adjacent side walls of said cans to *anchor* said end of said tape thereto” [R. 578].

In remarks covering the amendment Paulucci stated that claim 4 was like allowed claim 1:

“with the exception that instead of calling for the *stretching* of a portion of the resilient sticky tape to the can while in *stretched* condition, the tape is secured at one end to the aligned cans to *anchor* one end of the tape thereto” [R. 579].

The amendment was refused because the sought claim “is broader than any allowed claim” [R. 581].

But Paulucci was persistent. He fought back, saying [R. 582] “if you *secured* one end of the tape to the can and *then* stretched it would be outside the scope of Claim 1”.

The Examiner agreed with this observation [R. 583-584], but persisted in his refusal, with the approval of the Supervisory Examiner [R. 584].

Paulucci acquiesced, and paid the final fee [R. 584].

The efforts of Paulucci to amend are understandable. For five months the Johnson patent had been a public record. The loose tabbing "to anchor one end of the tape" (proposed claim 4 of Paulucci) was clearly disclosed.

It is no answer to say that perhaps neither Paulucci nor his solicitor saw the Johnson patent, for in December, 1950 or in January, 1951 [R. 227] there was delivered to Paulucci and his company in Duluth the prototype of the defendant's accused machine, which prototype employed the same tape-applying mechanism and method as that instantly questioned.

Paulucci by his proffered claim 4 tried to stretch his claims beyond the teaching of his specification, and beyond any claim covered by his Oath to the application. Now he endeavors to stretch his claim to cover that which the Patent Office refused him. A classic example of file wrapper estoppel and abandonment exists. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, 136-7. It is immaterial whether the Examiner was right or wrong. *Ibid.*

Plaintiffs made no attempt to prove that the operation of defendant's Dellenbarger machine includes "Step 2" of claim 1 of the patent in suit. Defendant's uncontroverted proofs, however, clearly establish that "Step 2" is not employed in the operation of defendant's machine.

In the operation of defendant's machine (see pp. 15-19, *supra*) in the starting position shown in Exhibit X [R. 675] there is a loose end of tape over the cans. This loose end is not stretched or held stretched at any time. In the first movement of the mechanism the "applying arm *M*" drops down towards the cans, and its "applying roller *L*" merely presses the loose end of the tape onto

the cans as shown in Exhibit X-1 [R. 676]. Thus, in its initial application to the cans, the end of the tape is not stretched or under any tension whatever. It is merely tabbed or pressed onto the cans in a loose condition. This is exactly what Paulucci's attorney told the Patent Office would avoid infringement of claim 1 (See pp. 9-12, *supra*).

Thus, defendant's Dellenbarger machine omits "Step 2" of claim 1 in suit, and thereby avoids infringement. Under the law, the omission of a material method or process step, with the omission of its function, avoids infringement.

See:

Alumino-Thermic Corp. v. Goldschmidt Thermit Co., 25 F. 2d 206 (C. C. A. 3rd 1928);

Jensen-Salsberg Laboratories, Inc. v. O. M. Franklin Blackleg Serum Co., 72 F. 2d 15 (C. C. A. 10th 1934);

Anthony v. Sherman, 159 F. 2d 995 (C. C. A. 4th 1947);

And See:

Western Well Work, Inc. v. Layne & Bowler Corp., 276 Fed. 465 (C. C. A. 9th 1921);

Simons v. Davidson Brick Co., 106 F. 2d 518 (C. C. A. 9th 1939).

"Step 3" of Claim 1 in Suit is as Follows:

"pulling on the portion of said tape not secured to said can in a direction substantially tangential to the periphery of the cans to place same in a stretched condition,"

"Step 3" is clearly defined in the Paulucci specification as follows: "The operator then grasps the newly cut end of the tape with the thumb and forefinger of one hand and pulls same away from the cans in a direction sub-

stantially tangential to the cans to apply tension to the tape and to stretch the same slightly" [Column 3, lines 67-72]. Note that the tape has been severed from the roll at this point [Column 3, line 62] and is stretched by hand. Up to this point in the Paulucci method, there has been no rotation of the cans.

With defendant's machine, after the initial anchoring of the loose end of the tape onto the cans, there is no pulling of the unattached tape away from the cans, much less stretching of the tape. After its first application of the loose end of the tape to the cans as shown in Exhibit X-1, there is a "free loop" of tape between the cans and the roll of tape, as shown in Exhibit X-1. The initial rotation of the cans merely takes up some of the slack in this "free loop", as shown in Exhibit X-2. Obviously, the unattached tape is not pulled or stretched in any way up to this point.

Thus, defendant's machine does not perform "Step 3" of claim 1 and for that additional reason does not infringe.

In the use of defendant's machine it is unnecessary to stretch the tape *during* application to secure conformation over the beads of the cans, for the soft buffing roller *P* presses the tape into conformation *after* application.

"Step 4" of Claim 1 is as Follows:

"and rotating said cans on their longitudinal axes while said tape is in said stretched condition to cause said tape to be applied and to adhere to the remainder of the periphery of said beads and adjacent side walls of said cans."

This last step is described in the Paulucci specification as follows: "As the tape is held in stretched condition, the operator rotates or rolls the two cans around axially in

the trough 6 by engaging either of the cans, for they are held together by the initially applied portion 14 of the tape. The cans 8 are rolled or rotated by the operator in a direction tending to wind the tape onto the cans, and because of the stretched condition of the tape and the tension thereon, the latter is applied and secured to the cans . . . [Column 3, line 72, to Column 4, line 6].” In other words, the unattached portion of the tape is stretched by pulling on it away from the cans before *any* rotation of the cans, and then while the tape is held stretched, the cans are rotated to wind the tape in stretched condition onto the cans.

In defendant’s machine the cans are rotated about one-half a revolution, to the position shown in Exhibit X-3 [R. 678], before there is any tension or pull on the tape, because up to this point there has been a loose “free loop” in the tape, as shown in Exhibits X-1 and X-2. There has been no stretching whatever of the tape, as required by “Step 4” during this part of the rotation of the cans. Then during the balance of rotation of the cans in defendant’s machine there is still no tension put on the unattached tape sufficient to stretch it as required by “Step 4.” It takes about 7½ pounds of pull to stretch the tape used by defendant’s machine, and since the tape merely rides over free-running, undriven rollers no such pull is put on the tape [R. 345].

Step 4, it will be noted, requires “stretched condition” for the entire rotation. If argumentatively we assume a “stretched condition” after the free loop is exhausted, such condition is not for the entire “remainder of the periphery”.

Thus, defendant does not employ “Step 4,” and for that additional reason does not infringe claim 1.

It is futile for plaintiffs to assert that merely unwinding the tape from the roll thereof exerts the tension required by the specification, for the specification requires hand stretching for the initial application and for the application while the cans are rotated.

The taping operation of defendant's Dellenbarger machine differs fundamentally from the method of claim 1 of the Paulucci patent. In the Paulucci method the tape is pulled and stretched both before and during application to the cans. In the operation of defendant's machine the tape is not pulled or stretched either prior to or during application to the cans, the tape being merely pressed or "wiped" onto the cans by defendant's applying and buffing rollers. Therefore, defendant's method has an entirely different mode of operation than that of claim 1 of the patent in suit.

Since defendant does not employ steps 2, 3, or 4 of claim 1 in suit, and since defendant's method has an entirely different mode of operation than that of claim 1, defendant does not infringe.

Plaintiff offered no proof of infringement, and did not attempt to rebut defendant's clear proof of non-infringement. Plaintiff relied upon an alleged similarity of appearance of plaintiff's and defendant's products to attempt to show infringement. However, mere similarity of result is not a test of infringement of a method claim.

See:

United States Rubber Co. v. General Tire & Rubber Co., 128 F. 2d 104 (C. C. A. 6th, 1942).

The foregoing demonstrates that Findings of Fact 14 and 15 [R. 85] are clearly erroneous and that defendant does not infringe.

POINT 2.

Claim 1 of the Paulucci Patent in Suit Is Invalid on Its Face for Lack of Invention, Consisting Only of Old and Well Known Steps and Involving Only Simple Mechanical Skill.

The alleged invention of claim 1 of the Paulucci patent in suit was stated by plaintiff's counsel at the trial as follows:

“ . . . the method of the patent in suit, which involves the use of a flexible tape, which is applied to the cans under tension, to the extent that it stretches the tape, so that the tape does not just lie over the flanges of the can, but it follows the contour of the flanges because of the stretch of the tape and the tension, as it is applied, and also goes down and grips the can on each side of the flanges.” [R. 111]

“ . . . the material part of that is using a stretchable tape, and putting that tape under tension, so that the tape stretches as it is applied, and the cans are rolled, so it will adhere around the beads and to the side walls of the can . . . ” [R. 115]

The Paulucci patent in suit teaches, if it teaches anything, that if anyone wants to tape two cans together end-to-end with conventional pressure-sensitive cellophane tape, the sticky tape should be held under tension while it is wrapped onto the cans to make it adhere properly. We suggest that this is known to anyone who has ever used pressure-sensitive cellophane tape to fasten together to objects. It does not require even the skill of a “mechanic” to know and employ this self-evidence procedure. Anyone who has ever tied two parcels together with common string knows that the string must be pulled tight to get a good package. The same is true of sticky tape.

Claim 1 of the Paulucci patent in suit refers to “stretching” the tape before and during application to the cans, merely by applying tension to the tape. Anyone who winds tape onto an object will put tension on the tape or otherwise it cannot be guided on smoothly. The patentee could not define how much tension is required in his method, merely saying that you use enough tension to make the tape go on smoothly and adhere to the cans [R. 59-60, 457-459], pointing out that one can take two cans in one hand and apply the tape with tension and get the same results as his claimed method [R. 62].

The specification states [Column 2, line 53] that the tape should be “slightly stretchable.” The same language appears in Column 3, line 72. In Column 3, lines 49 and 50, it is directed to stretch or pull the tape “between the fingers of the two hands.” The result to be accomplished by this direction is to “conform” the tape to the surface [Column 2, line 53], a purely functional statement. The specification is no more helpful or instructive than to tell a cook to put in his batter enough baking powder to make the cake rise. And, per the file wrapper, this indefiniteness is the exact point of novelty, namely, the application of tape “under strong tension” [R. 571].

Furthermore, it is the only thing which distinguishes the patented method from the plaintiffs’ practice prior to 1951.

The Paulucci patent leaves the question of how much tension to apply to the natural skill of a user. It is obvious that a user would come up with the same result without the Paulucci patent. The defendant independently did so in its hand-taping operations in 1949 (see pp. 8-9, *supra*).

The law is well established that when a patent claim lacks invention on its face, it should be held invalid, without the necessity of referring to any particular prior art.

See:

Towne Steering Wheel Co. v. Lee, 199 Fed. 777 (C. C. A. 9th 1912);

Rasmusson v. National Popsicle Corp., 111 F. 2d 453 (C. C. A. 9th 1940).

The statement of the Supreme Court in *Atlantic Works v. Brady*, 107 U. S. 192, 199, 2 S. Ct. 225, 231, 27 L. Ed. 438, as follows, is particularly apposite to claim 1 of the Paulucci patent here in suit.

“The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacturers.”

(Quoted with approval in *Emmett v. Metals Processing Corp.*, 118 F. 2d 796, 798, C. A. 9th.)

Judge Yankwich found [Findings 7 and 12] that the invention of the Paulucci patent resides in causing the tape to pass around an irregular contour to engage the side walls of two abutting cans, as well as the beads thereof, in a stretched condition, “*whereby the tape is extended transversely of its length at an intermediate section.*”

There is not a word in the Paulucci patent or in the evidence that would indicate any *transverse* stretching of the tape. The Paulucci patent teaches that the tape is

pulled lengthwise [Column 3, line 35 to Column 4, line 9], and specifically states that the tape is “tightly stretched *around* the cans [Column 2, lines 18 and 26].” How by pulling lengthwise on a tape it could be stretched *laterally* or *transversely* does not appear in the evidence, is contrary to the plain teaching of the patent, and is contrary to reason. This shows the obvious error in this portion of Findings 7 and 12.

POINT 3.

Claims 1, 2, and 3 Are Invalid Over the Prior Public Use, by Plaintiffs of Their Early Commercial Method and Apparatus.

The plaintiff Paulucci cynically admitted that he and plaintiff Chun King Sales, Inc. had used an apparatus substantially as shown in Fig. 3 of his patent in suit to tape cans together end-to-end starting in May or June, 1949, and continuing until August, 1951, in their extensive public commercial operations during that period (see pp. 6-8, *supra*). The apparatus shown in Fig. 3 of the Paulucci patent is covered by claims 2 and 3 thereof, which were submitted to the Patent Office in Paulucci's original application [R. 566]. As to such apparatus, Paulucci made an *oath* to the effect that such apparatus *had not been in public use* more than one year prior to his application on May 14, 1952 [R. 567]. Such oath obviously was false in view of his own public use of such an apparatus for almost *three* years prior to the filing of his application, and he knew it. We suggest that this was the baldest perjury by Paulucci and that his testimony and plaintiffs' case is thereby completely impeached.

In any event, the only alleged difference between plaintiffs' 1949-1951 taping method and that of claim

1 of the patent in suit was the amount of tension applied to the tape during the taping operation [R. 198-199].* We assert that merely increasing the amount of tension applied to the tape while it is wound on the cans, to obtain a smoother application of the tape, does not rise to the dignity of invention, and that claim 1 is clearly invalid for lack of invention over plaintiffs' own prior art taping method.

It is well established that an alleged invention which involves merely a change in degree from the prior art is not patentable, and any patent covering only such a change in degree is invalid.

See:

Greene Process Metal Co. v. Washington Iron Works, 84 F. 2d 892 (C. C. A. 9th 1936);

Bingham Pump Co. v. Edwards, 118 F. 2d 338 (C. C. A. 9th 1941).

The foregoing shows the clear error in Findings 11, 16, and 24 [R. 84-87].

In addition, it is to be noted that the District Court found in Finding 17 [R. 85] that all prior attempt by plaintiffs proved a failure and were abandoned. This is clearly erroneous because the evidence is uncontroverted that plaintiffs continuously taped thousands of cases of cans of food from June, 1949, until August, 1951, using their original taping method (see pp. 6-8, *supra*). Plaintiffs did not get any rejects of its taped products because the cans were coming apart [R. 404].

*The testimony of Paulucci [R. 199] is as follows:

"Q. Were there any differences in the operation other than the amount of tension applied to the tape? A. Basically, the amount of tension applied to the tape.

Q. That was the only difference? A. Yes, sir."

There is no evidence to support such a finding and it is directly contrary to the evidence.

The method of claim 1 and V-trough apparatus of claims 2 and 3 commercially employed by plaintiffs more than one year prior to Paulucci's filing date cannot validly be patented in the Paulucci patent: see *Pennock v. Dialogue*, 2 Peters (U. S.) 1, 4, 19, 7 L. Ed. 327; *Macbeth-Evans Glass Co. v. General Electric Co.*, 246 Fed. 695 (C. C. A. 6th 1917); and *Metallizing Engineering Co. v. Kenyon Bearing & A. P. Co.*, 153 F. 2d 516, 518-20, and cases there collected (C. C. A. 2d 1946, Opinion by Judge L. Hand).

POINT 4.

Claim 1 Is Invalid Over the Prior Public Use by Defendant of Its Hand-Taping Operation.

Defendant commercially taped over 1,000 cases of cans together end-to-end with sticky cellophane tape from June, 1949, until early in 1950, and resumed such hand-taping in 1954 and has continued to do so until today (see pp. 8-9, *supra*). Defendant's hand-taping operation today does not differ from that used by it in 1949 [R. 469-470]. There is no evidence in this case that any of defendant's hand-taping operations were in any way unsatisfactory. Defendant's present use of such hand-taping and its extensive sales of its hand-taped products is cogent proof of the contrary. This shows the obvious error in Finding 17 [R. 85] to the effect that defendant's hand-taping operations "proved a failure and were abandoned." Physical Exhibit 12 illustrates two of defendant's cans taped together substantially as in its 1949 taping operations [R. 469-470], and it is obviously a satisfactory taping job.

In defendant's 1949 hand-taping operations, tension was put on the tape while it was being wound on the cans, to make it stretch over the beads and onto the side walls of the cans [R. 468-469, 473-475].

If claim 1 of the Paulucci patent in suit is construed broadly enough to cover merely stretching the tape as it is applied to a pair of cans, such method is exactly that commercially used by defendant in 1949 and claim 1 is directly anticipated thereby and is invalid. We suggest, in addition, that even if claim 1 is construed to be limited to the specific steps described therein (as it should be), still such method does not involve any invention over defendant's 1949 hand-taped method and is invalid for that reason.

POINT 5.

Claim 1 of the Paulucci Patent in Suit Is Invalid for Lack of Invention Over the Prior Art Patent to Johnson, DX-S.

If claim 1 of the Paulucci patent in suit is construed broadly enough to cover the defendant's Dellenbarger machine, claim 1 is invalid for lack of invention over and anticipated by the Johnson patent No. 2,652,166 [DX-S, R. 659.]

Defendant's accused Dellenbarger machine was made by the Dellenbarger Machine Company under license from the owner of the Johnson patent (see pp. 12-13, *supra*). Plaintiff by cross-examination of the disinterested technical witness Peterson, established the identity of function and similarity of parts between defendant's accused Dellenbarger machine and the taping machine of the Johnson patent [R. 305-311]. This was confirmed by the engineering expert Johnson [R. 333-334]. (The witness Johnson is not the patentee Johnson.)

It will be remembered that the taping mechanism of the Johnson patent was embodied in the prototype machine which was designed and built by the witness Peterson and tested at the plaintiffs' plant January to April, 1951 (see pp. 13-14, *supra*). Consequently, Peterson had full knowledge of the function and operation of the taping machine of the Johnson patent. Similarly, the witness Johnson had familiarity with such prototype machine [R. 334-335].

The Johnson patent, DX-S, was applied for on May 29, 1950, and long prior to June, 1951, plaintiffs' earliest claimed date of conception of the invention for the Paulucci patent in suit [R. 120]. Consequently, the Johnson patent is prior art as to the Paulucci patent.

See:

Alexander Milburn Co. v. Davis-Bournonville Co.,
270 U. S. 390, 46 S. Ct. 324, 70 L. Ed. 651;

Detrola Radio & Television Corp. v. Hazeltine Corp., 313 U. S. 259, 61 S. Ct. 948, 85 L. Ed. 1319.

Although the Johnson patent describes and claims a taping machine, its operation in applying tape to cans is substantially the same as that of defendant's accused machine, as Peterson and Johnson testified. Consequently, if claim 1 of the Paulucci patent in suit covers the operation of defendant's machine the Johnson patent is a proper basis for finding lack of invention as to method claim 1.

A method claim which covers nothing more than the operation of a machine or of a prior art patent is invalid.

See:

Busch v. Jones, 184 U. S. 598, 22 S. Ct. 511, 46 L. Ed. 707;

United States Consol. Seeded Raisin Co. v. Selma Fruit Co., 195 Fed. 264, 270 (C. C. A. 9th 1912);
McDaniel v. Friedman, 98 F. 2d 745 (C. C. A. 7th 1938).

We concede that the operation of the machine of the Johnson patent, DX-S, would not put enough tension on the tape to stretch it, but, by the same token defendant's accused Dellenbarger machine does not put enough tension on the tape to stretch it. Similarly, we concede that the machine of the Johnson patent does not stretch the tape before its initial application to the cans, but defendant's accused machine likewise does not stretch the tape before initial application to the cans. If claim 1 of the Paulucci patent is construed to be limited to its plain terms, as we suggest it must be, we concede that claim 1 could be valid over the Johnson patent; but if so construed, claim 1 is not infringed by defendant's machine (see pp. 28-35, *supra*). In short, claim 1 of Paulucci cannot be both valid over Johnson, and infringed by a method which utilizes the function and operation of the Johnson patent.

The Johnson patent, DX-S, was not considered by the Patent Office in connection with the application for the Paulucci patent in suit. Consequently, the normal presumption of validity arising from the issuance of the Paulucci patent is greatly weakened if not entirely destroyed.

See:

Gomez v. Granat Bros., 177 F. 2d 266 (C. C. A. 9th 1949);
Jacuzzi Bros., Inc. v. Berkeley Pump Co., 191 F. 2d 632 (C. C. A. 9th 1951).

POINT 6.

Claim 1 of the Paulucci Patent in Suit Is Invalid for Lack of Invention Over the Nifong Patent, DX-K.

The Nifong patent, DX-K [R. 608] likewise was not considered by the Patent Office in connection with the application of the Paulucci patent in suit. Since Nifong is so very pertinent to the subject matter of the patent in suit, it is suggested that if the Patent Office Examiner had found and considered the Nifong patent, he never would have allowed claim 1 of the patent in suit.

The Nifong patent shows and describes a can-taping machine and its method of operation. It is designed primarily to tape the tops onto cans, by wrapping a sticky resilient tape around the juncture of the can and top, by affixing the free end of the tape to the can and top junction; then holding the can and top forcibly together while holding the tape under tension while the can and top are rotated to wind the tape over the junction of can and top, thus securing the top to the body of the can. It obviously could be used to tape two cans together end-to-end. It might involve a slight change in mechanism to substitute a can for the top of can; but there would be no change in method.

The Paulucci patent in suit plainly teaches that if the tape is applied under the required tension it will stretch to conform to the shape of the beads and will extend down onto the side walls of the cans on each side of the bead, as shown in Fig. 2, instead of merely adhering to the beads as shown in Fig. 5 in the absence of such stretching of the tape [Column 4, lines 2 to 35].

In the Nifong patent likewise the tape is put under sufficient tension to conform to the shape of the bead 146 and to extend down smoothly onto the side walls of the can and top. This is clearly shown in Figs. 1, 3,

7, and particularly in Fig. 16 of the Nifong patent, which show the tape 87 conforming to the irregular contour of the bead exactly as shown in Fig. 2 of the Paulucci patent in suit. Consequently, the method of the Nifong patent obtains identically the same result as the method of claim 1 of the Paulucci patent in suit, and does so in exactly the same way, *i.e.*, by holding the tape under tension as it is wound over the can bead and onto the side walls.

The Nifong patent states, page 6, Column 3, lines 26-31:

“Particular attention is called to the fact that the tape 87 having the adhesive thereon is held taut at a substantially uniform tension during the entire revolution of the can, and this aids materially in the proper application of the tape.”

The can in Nifong, with its beaded top and cover, is turned a complete revolution “while contacting the taut tape” [p. 1, Column 1, lines 51-54].

Paulucci also imitates Nifong by a slight over-lapping of the tape. [Compare Column 4, lines 10-13 of Paulucci and p. 6, Column 2, lines 46-48, Nifong].

The District Court obviously did not understand the Nifong patent or its pertinency, dismissing it merely as “an elaborate piece of machinery” [R. 523], and then stating in the Opinion, “There is no method . . . for applying tension to or stretching the tape either before or after application in order to cause it to pass around an irregular contour [R. 68].” In Nifong, as pointed out above, tension is applied to the tape during its application over the bead 146 in order to cause the tape to pass around the irregular contour of the bead and onto the side walls, exactly as in the Paulucci patent in suit. This demonstrates the clear error in the District Court’s Opinion and in Findings 18 and 19 [R. 86].

POINT 7.

Apparatus Claims 2 and 3 Are Invalid for Lack of Invention Over the Prior Art and Are Not Infringed.

Claims 2 and 3 of the Paulucci patent in suit cover merely a V-shaped trough or “angle-iron” and a conventional tape dispenser mounted on a base.

The use of V-shaped troughs to hold cylindrical objects in alignment end-to-end while they are being wrapped together is old in the art, being shown in the Ewart patent No. 2,590,241, Exhibit R [R. 655], in which it serves exactly the same purpose as in the Paulucci patent. The tape dispenser 2 of the Paulucci patent is admitted therein to be of “any desired conventional type” [Column 2, lines 30-31].

Thus, both the V-shaped trough and the tape dispenser shown in the Paulucci patent were separately old and conventional in the prior art, in which they served the same purpose in the same way as they do in the patent in suit. Merely putting them together, as in the Paulucci patent, accomplishes no new function and claims 2 and 3 are obviously invalid as covering mere aggregations of old elements and lacking in invention.

The plaintiffs at the trial in the Court below withdrew its charge of infringement as to claims 2 and 3 [R. 109, 506]. In view of this concession of non-infringement, the only remaining issue as to claims 2 and 3 is as to their validity.

Since apparatus claims 2 and 3 are obviously lacking in invention, we suggest that this Court should decide this issue on this appeal and not remand the case to the District Court on this issue. Such a remand would greatly delay

the final disposition of the case, and, we suggest, justice to the defendant requires an early final decision on this issue. On any such remand, defendant would rely solely on the evidence and facts now before this Court, as to which there is no conflict. This issue involves merely a question of law which can and should be decided by this Court.

See:

Waterloo Min. Co. v. Doe, 82 Fed. 45 (C. C. A. 9th 1897).

The issue as to the validity of claims 2 and 3 having been raised by the plaintiffs' Complaint and by defendant's counterclaim, the District Court should have decided this issue and its failure and refusal to do so is clear error.

See:

Altvater v. Freeman, 319 U. S. 359, 63 S. Ct. 1115, 87 L. Ed. 1450;

Trico Products Corp. v. Anderson Co., 147 F. 2d 721 (C. C. A. 7th 1945);

Dominion Electrical Mfg. Co. v. Wiegand Co., 126 F. 2d 172 (C. C. A. 6th 1942).

However, it would serve no useful purpose to remand the case on the sole issue as to the validity of apparatus claims 2 and 3 of the Paulucci patent, since this Court can decide the legal issue on the present record and appeal.

VI.
CONCLUSION.

Claim 1 of the Paulucci patent in suit is at best a narrow, detailed claim, as limited by its plain terms, by file-wrapper estoppel, by the prior art patents to Johnson and Nifong, and the prior public uses by both plaintiffs and defendant. The method defined by claim 1 has never been used by plaintiffs, defendant, or anyone else, and consequently the Paulucci patent is a mere "paper patent" which has no commercial success and which is not infringed by defendant.

If the plain limitation of claim 1 are ignored and the claim is expanded by interpretation to cover the operation of defendant's Dellenbarger machine, then claim 1 is anticipated by and lacks invention over the prior art patents to Johnson and Nifong, and the prior public uses of both plaintiffs and defendant. In any event, claim 1 defines a method which amounts merely to mechanical skill over the art, and is invalid on its face for lack of invention.

It is respectfully submitted that the judgment of the District Court is clearly erroneous and should be reversed, either on the ground that claim 1 of the Paulucci patent is invalid, or on the ground that if valid it is not infringed by the defendant.

Claims 2 and 3 are also invalid and should be so adjudicated.

Respectfully submitted,

HARRIS, KIECH, FOSTER & HARRIS,
FORD HARRIS, JR.,

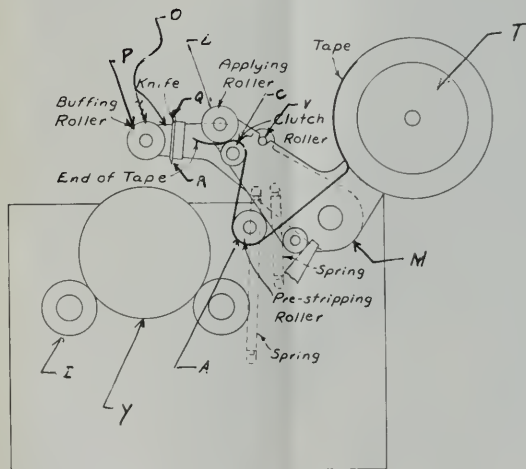
WALTON EUGENE TINSLEY,

By FORD HARRIS, JR.,

*Attorneys for Appellant,
Oriental Foods, Inc.*

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Fig. 1.



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 Defendant
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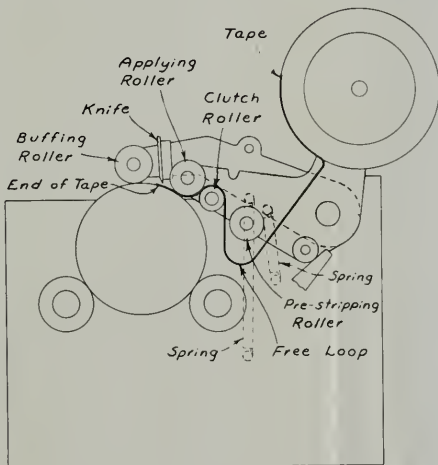
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Fig. 2.

Clark, L. B. 1911

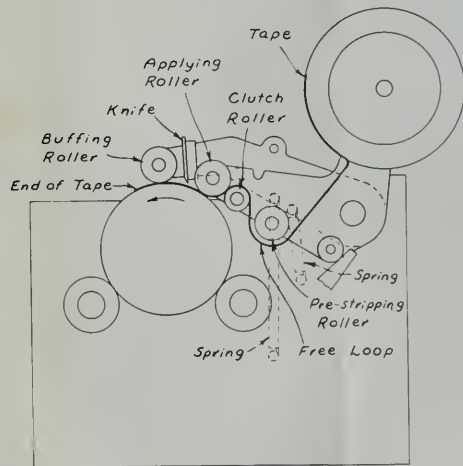
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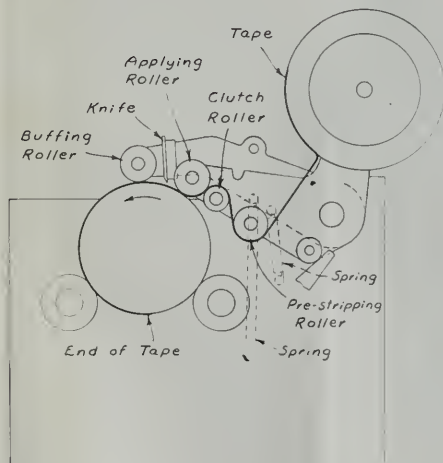
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Fig. 3.



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Fig. 1. *Ruep*



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 Fig. 5. *W. Conley*

